

REMARKS

The Official Action mailed June 3, 2010, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on June 30, 2006.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 14-37 were pending in the present application prior to the above amendment. (Although the Office Action Summary shows that claims 1-37 are pending and that claims 1-13 are withdrawn, the Applicant notes that in the *Amendment and Response to Restriction Requirement* filed on January 22, 2010, claims 1-13 were canceled.) Claims 15 and 27 have been amended to better recite the features of the present invention, and new claims 38 and 39 have been added to recite additional protection to which the Applicant is entitled. The Applicant notes with appreciation the indication of the allowability of claims 24 and 36. Accordingly, claims 14-39 are now pending in the present application, of which claims 14, 15, 26 and 27 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 14-17, 25-29 and 37 as anticipated by U.S. Publication No. 2003/0216012 to Sasaki. The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Specifically, independent claims 14 and 26 recite “producing a first laser beam emitted from a laser oscillator into a second laser beam by passing through a slit” and independent claims 15 and 27 recite “producing the third laser beam into a fourth laser beam by passing through a slit.” For the reasons provided below, the Applicant respectfully submits that Sasaki does not teach the above-referenced features of the present invention, either explicitly or inherently.

The Official Action asserts that “Sasaki et al discloses ... a slit 76 (Figure 22, and Paragraph 0133)” (pages 2 and 3, Paper No. 20100522). The Applicant respectfully disagrees and traverses the assertions in the Official Action. Sasaki discloses a substantially semicircular cylindrical lens 76, which is used for “light condensing” and which is not used as a slit, which, for example, is “for blocking opposite end portions of a laser beam” (paragraph [0019] of the pre-grant publication of the present application, i.e. U.S. Publication No. 2009/0173893). Therefore, the Applicant respectfully submits that Sasaki does not teach “producing a first laser beam emitted from a laser oscillator into a second laser beam by passing through a slit” and independent claims 15 and 27 recite “producing the third laser beam into a fourth laser beam by passing through a slit,” either explicitly or inherently.

Since Sasaki does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects dependent claims 18-23 and 30-35 as obvious based on the combination of Sasaki, U.S. Publication No. 2003/0086182 to Tanaka and U.S. Publication No. 2006/0138102 to Sawada. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Sasaki. Tanaka and Sawada do not cure the deficiencies in Sasaki. The Official Action relies on Tanaka and Sawada to allegedly teach the features of the above-referenced dependent claims. Specifically, the Official Action relies on Tanaka to allegedly teach, e.g., “a laser beam emitted from a YAG laser, YVO₄ laser, YAIO₃ laser, an alexandrite laser, a Ti:sapphire laser, an Ar gas laser, or a Kr gas laser” (page 4, Paper No. 20100522) and on Sawada to allegedly teach, e.g. “a laser beam having a pulse width in femtoseconds, and that the laser [beam] is a Ti:sapphire laser” (Id.). However, Sasaki, Tanaka and Sawada, either alone or in combination, do not teach or suggest that Sasaki should be modified to include “producing a first laser beam emitted from a laser oscillator into a second laser beam by passing through a slit” or “producing the third laser beam into a fourth laser beam by passing through a slit.” Since Sasaki, Tanaka and Sawada do not teach or suggest all the claim limitations, a *prima facie* case

of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 38 and 39 have been added to recite additional protection to which the Applicant is entitled. For the reasons stated above, the Applicant respectfully submits that new claims 38 and 39 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,


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